

# Office Action Summary

Application No.

10/046,480

Applicant(s)

Shiraiwa

Examiner

Mark Wallerson

Art Unit

2626



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 63-66 and 68-71 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 63-66 and 68-71 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/062,552.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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### **Part III DETAILED ACTION**

#### ***Notice to Applicant(s)***

1. This action is responsive to the following communications: amendment filed on **11/3/2003**.
2. This application has been reconsidered. Claims 63-66 and 68-71 are pending.

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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4. Claims 63, 64, 65, 66, 68, 69, 70, and 71 are rejected under 35 U.S.C. 102(e) as being anticipated by Haneda (U. S. 6,243,171).

With respect to claims 63, 65, 66, 70, and 71, Haneda discloses an image reproduction control apparatus (figure 1) comprising a storage unit using a detachable memory (column 14, lines 30-32), the detachable memory storing a plurality of reproducible images (column 14, lines 56-65) and a reproduction instruction file (which reads on parameter data or order information) (column 15, lines 53-63 and column 18, lines 33-36), including file names specifying one or more images to be reproduced, the file name in an order (figure 17); a reading section for reading the reproduction instruction file (column 18, lines 55-67); a reproduction control section for controlling reproduction of the images by reading the images to be reproduced (column 15, lines 53-63 and column 20, lines 53-67); a display control section (17) for controlling display in a display unit (column 17, lines 46-56) so that a user may confirm whether or not reproduction of one or more images is to be performed (column 3, lines 53-63, column 5, lines 40-50, column 17, lines 46-56, and column 18, lines 5-36 and lines 50-67), the display means displaying thumbnail (reduced) images corresponding to images stored in the detachable memory (user's recording medium), wherein the reduced images displayed are distinguished between images that have been designated by the reproduction instruction file and images that have not been designated (which reads on an input unit for entering order data with regard to an image displayed) (column 5, lines 40-48; column 7, lines 17-28, column 10, lines 35-44 and column 19, lines 4-7), and starting the reproduction in accordance with input from a user (the user enters the printing conditions)

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(column 20, lines 57-67), and performing the reproduction of images to be reproduced after the user confirms that the images specified by the reproduction instruction file are to be reproduced (the images are printed after the order data is read) (column 10, lines 35-44 and column 20, lines 45-67), wherein, in the confirmation, the thumbnail images are reproduced as images to be displayed (column 1, line 57 to column 2, line 4).

Haneda also discloses determining whether the instruction file is in the detachable memory (column 21, lines 58-67 and column 22, lines 59-61).

With respect to claim 64, Haneda discloses recording the instruction file in the detachable memory in accordance with user input (column 18, lines 25-36).

With respect to claim 68, Haneda discloses the reproduction instruction file (order file) includes one or more reproduction instructions (size or trimming), and one of the instructions is a print instruction (number of copies) (figure 18).

With respect to claim 69, Haneda discloses the display section is operated in accordance with the attachment of the memory (column 10, lines 3-12).

### ***Response to Arguments***

5. Applicant's arguments filed 11/3/03 have been fully considered but they are not persuasive.

Applicant submits that Haneda does not disclose displaying thumbnail images corresponding to the images stored in the detachable memory, wherein the thumbnail images

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displayed are distinguished between images that have been designated by the reproduction instruction file and image that have not been designated. The Examiner disagrees.

Haneda discloses displaying a large number of reduced images and desirable images are designated among those reduced images (column 7, lines 24-28), and starting the reproduction in accordance with input from a user (the user enters the printing conditions) (column 20, lines 57-67), and performing the reproduction of images to be reproduced after the user confirms that the images specified by the reproduction instruction file are to be reproduced (the images are printed after the order data is read) (column 10, lines 35-44 and column 20, lines 45-67), wherein, in the confirmation, the thumbnail images are reproduced as images to be displayed (column 1, line 57 to column 2, line 4).

### *Conclusion*

6. All claims are rejected.
7. Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE

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OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Wallerson whose telephone number is (703) 305-8581.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, DC 20231

or faxed to:

(703) 872-9314 (for formal communications intended for entry)

(for informal or draft communications, such as proposed amendments to be discussed at an interview; please label such communications "PROPOSED" or "DRAFT")

or hand-carried to:

Crystal Park Two  
2121 Crystal Drive  
Arlington, VA.  
Sixth Floor (Receptionist)

**MARK WALLERSON**  
**PRIMARY EXAMINER**

Mark Wallerson